

REMARKS

Claims 1-23 are pending in the application. In an Office Action mailed June 13, 2005, Claims 1-8, 11, 13-19 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews et al. (WO 01/77669 A1) in view of Aune et al. (U.S. Patent No. 5,023,805); Claims 9, 10 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews et al. in view of Aune et al., and further in view of Wang et al. (WO 02/060662 A2) and Pellerin et al. (U.S. Patent No. 5,024,091); and Claims 12 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews et al. in view of Aune et al., and further in view of Larsson et al. (U.S. Patent No. 6,347,542 B1).

By the present Amendment, Applicants amended Claims 1 and 13 and canceled Claim 2. In view of the above claim amendments and the remarks that follow, Applicants respectfully submit that Claims 1 and 3-23 are in condition for allowance. Notice to that effect is requested.

The Rejections Under 35 U.S.C. §103(a)

Claims 1-8, 11, 13-19 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews et al. (WO 01/77669 A1) in view of Aune et al. (U.S. Patent No. 5,023,805). Applicants assert that the rejection of these claims is improper for the reasons that follow.

On page 3 of the Office Action, the Examiner states that "Andrews et al. discloses the claimed invention with the exception of the density being specifically measured by detecting radiation absorption in the test object". The Examiner then cites Aune et al. as allegedly teaching these missing elements.

For a *prima facie* case of obviousness, there must first be a suggestion or a motivation either in the references or in the knowledge generally available to modify a reference or to combine references. Second, there must be a reasonable expectation of success, and, third, all the claim limitations must be taught or suggested by the prior art references.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. Section 2143.01, p. 2100-124, August 2001.

Independent Claims 1, 14 and 17 define methods and a system for determining modulus of elasticity, or bending stiffness, of an object. The Examiner relies on Aune et al. to teach measurement of density by detecting radiation absorption in the test object. However, Aune et al. merely teaches the use of radiation absorption to determine a cutting solution for a log. There is absolutely no teaching or suggestion whatsoever in Aune et al. that the measurements taken may be used to determine a modulus of elasticity or bending stiffness of an object. In fact, nowhere in the text of the patent are the concepts of “stiffness” or “modulus of elasticity” even mentioned. Accordingly, Applicants assert that no motivation exists to combine Andrews et al. with Aune et al. to achieve Applicants’ methods and system for determining modulus of elasticity or bending stiffness as defined in independent Claims 1, 14 and 17.

Wang et al., Pellerin et al. and Larsson et al., cited in the other rejections, do not remedy the above-mentioned deficiencies. Moreover, these references are merely cited as allegedly teaching various narrower elements defined in the claims depending from Claims 1, 14 and 17.

Thus, because none of the references, taken either singly or in combination, teach or suggest the elements of independent Claims 1, 14 and 17, the rejections of these claims under 35 U.S.C. §103(a) have been overcome. Claims 3-13 depend from Claim 1; Claims 15 and 16 depend from Claim 14; and Claims 18-23 depend from Claim 17. These claims are also believed allowable as they further define limitations of their base claims.

CONCLUSION

In light of the foregoing amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Applicants respectfully request entry, reconsideration, and allowance of all currently pending claims. The Examiner is invited to telephone the undersigned if there are any remaining issues.

RESPECTFULLY SUBMITTED,

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